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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/385,299	08/30/1999	ALI MOSLEH	93-3-513	8955

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EXAMINER

RIMELL, SAMUEL G

ART UNIT	PAPER NUMBER
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2164

DATE MAILED: 11/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/385,299

Applicant(s)

MOSLEH ET AL.

Examiner

Sam Rimell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 30-54 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3, 4, 32, 33 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5-17, 30, 31 and 34-54 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2, 5-17, 30-31 and 34-54 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 7, 12, 30, 36 and 41: Each of these claims have be amended to recite the phrase “..medium that is selected by the portable access device based on the communication protocol..”. The original specification does not support the concept of making the selection of the medium based on a communication protocol. The relevant discussion appears in the specification at page 9, where it states:

The actual selection of a particular channel will be service dependent and a function of the user's whereabouts, the desired quality of the connection, and the costs of the connection. One of the elements used to determine the selection of a specific channel for communications, either local or wide area, is the available network and its coverage area. The selection will also depend on the destination server's configuration which may include: in campus wired Ethernet LANs, hospital wide wireless Ethernet, wide area wireless networks, and the Public Switched Telephone Network (PSTN) connections using standard modems.

The first sentence makes no mention of using a communications protocol as a factor in the selection of a communications medium. The second and third sentences only refer to the

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general type of destination network, such as a wireless LAN or WAN. The actual protocol used on the network is not recited as a deciding factor in selecting the network.

Accordingly, from each of claims 1, 7, 12, 30, 36 and 41 are new matter.

Claims 2, 5-6, 8-11, 13-17, 31, 33-35, 37-40 and 42-50: Depend from the independent claims 1, 7, 12, 30, 36, 41 respectively.

Claim 51: Claim 51 has been newly added and recites “..a second attempt to establish communication via a remote wireless network if the first attempt fails..”. This feature is not supported in the original specification.

The discussion of the first, second and third attempts are illustrated in FIG. 8, and discussed in the specification at page 25. The relevant discussion from the specification reads as follows:

“If, in step 274, the ICS module 304 determines the wireless LAN is out of range, it attempts to communicate via the cellular network in step 278.”

Claim 51 states that if the first attempt fails, an attempt is made to contact a “remote wireless network”, which is not necessarily the same as the cellular network required in the specification. For example, the “remote wireless network” could a remote LAN or the Internet, not a cellular telephone network as recited. Accordingly, the recitation in claim 51 is broader in scope than what the original specification allows for, and thus the recited quotation in claim 51 is of new matter.

Allowable Claims: Claims 3, 4, 32 and 33 are allowed.

Remarks

Applicant's arguments have been considered.

With respect to the rejection of claims 1, 7, 12, 30, 36 and 41, applicant's conclusion is summarized at page 3, lines 8-9, where applicant asserts that "The communication protocol is part of the communication profile and the communication protocol is used in making the selection of medium". In reviewing all of the quotations and Tables recited, neither of these assertions are supported. First of all, none of the quoted passages state that the communication protocol is part of the communication profile. Page 24, lines 1-2 is the only quotation which makes any mention of the communication protocol, and while this quotation recognizes the existence of a communication protocol, it does associate that protocol with the communication profile. Additionally, none of the quotations provided indicate that a medium is selected based on the protocol. While a protocol is recognized to exist, there is no suggestion in the specification that the protocol factors into the selection of a communications medium. Accordingly, this portion of the rejection is sustained.

Claim 51 was rejected for its reference to a second attempt via a remote wireless network if the first attempt fails. Applicant quotes from the specification at page 16, lines 8-10, which do discuss the scenario of a failed attempt, but make no mention of making a second attempt on a remote wireless network. Applicant also refers to page 16, lines 20-23 which does refer to a "remote wireless Ethernet", but this discussion is not made in reference to a connection failure. Rather, this discussion is directed to scenario of when the communications profile is not stored, and the first attempt successfully connects to a wireless network. This is not the scenario

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described in claim 51, where the first attempt fails and the subsequent attempt is made to a remote wireless network.

An additional problem arises in that the claims make reference to a connection to a "remote wireless network" if the first attempt fails. This is a broader recitation than what the original disclosure allowed. While the original disclosure makes references to "wireless Ethernets", for communications, there is no reference to "remote wireless networks", which are broader in scope than just wireless Ethernets and can encompass features not taught in the original disclosure.

The lack of direct teaching in the quoted passages combined with claims directed to broader recitations than permitted in the original disclosure indicate that the rejection should be sustained.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (571) 272-4084.

A handwritten signature in black ink, appearing to read 'S. Rimell', written in a cursive style.

Sam Rimell
Primary Examiner
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